

## REMARKS

### 1. Restriction/Election

#### a. Election

On pages 2-4 of the Office Action, the Examiner requires election of a single invention from the following groups under 35 U.S.C. §§ 121 and 372:

Groups 1-3353, claims 21-50, drawn to an isolated viral nucleic acid, wherein the nucleic acid is selected from SEQ ID NOs: 1-3353.

Specifically, the Examiner requires election of a single disclosed virus and its corresponding SEQ ID NO. Applicant with traverse elects herpes simplex virus and SEQ ID NO: 2079, which is related to claims 21-34.

#### b. Traversal

The Examiner alleges that the inventions listed as groups 1-3353 do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features under PCT Rule 13.2. *Office Action*, p. 2. In restricting the claimed subject matter, the Examiner applies Section (f)(i)(a) of Annex B of the PCT Administrative Instructions (AI), asserting that “the special technical feature as defined by PCT Rule 13.2 shall be considered to be met when all the alternatives of a Markush-group are of similar nature” (emphasis added). *Id.*

The Applicant respectfully traverses. Specifically, claims 21-49 do not recite a Markush group and the Examiner has improperly applied PCT Rule 13.2 to these claims. Claims 21-49 are not relevant to an inquiry for a lack of unity based upon the Markush group of nucleic acids set forth in SEQ ID NOS: 1-3353. Accordingly, the Applicant assumes the Examiner has mistakenly asserted a lack of unity for claims 21-49 and will only address the Examiner’s assertions regarding PCT Rule 13.2 for claims 50 and 51.

With regard to claims 50 and 51, the Applicant respectfully traverses the Examiner’s restriction of claims 50 and 51 under PCT Rule 13.2. Specifically, claims 50 and 51 depend from independent claims 21 and 35, respectively. Under PCT Rules 13.1 and 13.2, “[u]nity of invention has to be considered in the first place only in relation to the independent claims in an international application, and not the dependent claims” (emphasis added). *AI Annex B, Part I(c)*. Furthermore, “[i]f the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of unity arises in respect of any claims that depend on the independent claims” (emphasis added). *AI Annex B, Part I(c)(i)*. Since the subject matter of claims 21 and 35 have unity of invention, as previously asserted by Applicant and found to be persuasive to the Examiner, Applicant submits that the subject

matter of all claims depending from claims 21 and 35, including claims 50 and 51, have unity of invention (See Applicant's Reply under 37 C.F.R. § 1.111 submitted on July 20, 2007).<sup>1</sup>

Moreover, Applicant submits that the subject matter of claims 50 and 51 has unity of invention. From their dependency on independent claims 21 and 35, respectively, claims 50 and 51 must contain all the features of the independent claims. *AI Annex B, Part 1(c)*. The nucleic acids of claims 21 and 35, respectively, all share common structural features. The nucleic acids of claim 21, and thus claim 50, consist of 17-24 nucleotides, and are contained within a hairpin nucleic acid (50 to 131 nucleotides in length) with a specific stem length (19 to 71 nucleotides in length), loop segment length (3 to 19 nucleotides in length), and stem segment complementarity. The nucleic acids of claim 35, and thus claim 51, are related to the hairpin nucleic acid. The Dicer enzyme complex recognizes the common hairpin structure and "dices" it into a miRNA. *Instant Application*, p. 10.

The nucleic acids of claims 21 and 35, and therefore claims 50 and 51, respectively, also share common activities. The nucleic acids of claims 21 and 50 are all capable of binding to a binding site of a mRNA, and of inhibiting expression of a protein encoded by the mRNA. The nucleic acids of claims 35 and 51 are related to hairpins that contain the active nucleic acids of claims 21 and 50. Accordingly, all the alternative nucleic acids of claims 50 and 51, respectively, share significant structural elements and a common protein expression-inhibiting activity. In view of the foregoing, Applicant submits that the claimed subject matter has unity of invention, and respectfully requests that the Examiner reconsider and withdraw the restriction requirement under 35 U.S.C. §§ 121 and 372.

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<sup>1</sup> In Applicant's Reply filed July 20, 2007 and subsequent Office Action of September 26, 2007, the Applicant argued and the Examiner acknowledged that the viral miRNAs/hairpins precursors were neither taught nor suggested in the prior art at the time of filing the instant application, and therefore the claimed subject matter contributed over the prior art because the claimed nucleic acids have a common special technical feature of being related to isolated viral miRNA/hairpin precursor nucleic acids.

## 2. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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